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APR 28 2004

**DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600**

In re Application of: Mitchell R. Bauer	:	PETITION TO WITHDRAW
Application No. 09/556,647	:	OBJECTIONS TO THE
Filed: April 24, 2000	:	SPECIFICATION AND
Attorney Docket No.: 8778.00	:	DRAWINGS UNDER
For: MATERIAL BROWSER	:	37 C.F.R. 1.181

This is in response to applicant's petition filed on December 19, 2003 to have the objections to the specification set forth in the October 22, 2003 Office action withdrawn and to have the proposed drawing corrections filed on January 14, 2003 approved.

The petition is **GRANTED-IN-PART**.

Petitioner argues that in the Office actions dated June 6, 2003 and October 22, 2003 the examiner objected to the specification as failing to provide proper antecedent basis with respect to several "means plus function" clauses. Further, petitioner urges that the identified "means plus function" clauses are adequately described in the specification and that verbatim antecedent support in the specification is indicated in the amendment dated October 21, 2002 and that the "means" words find implicit support in the specification in accordance with Section 112, para. 6. The petition also urges that the proposed drawing correction filed on January 14, 2003 be acknowledged by the Office and approved.

A review of the file history indicates that the examiner in both the June 6, 2003 and October 22, 2003 Office actions objected to the specification as failing to provide antecedent basis for several of the "means plus function" clauses set forth in claim 22. MPEP Section 2181 is very clear on the handling of proper antecedent basis for terms used in the specification and states "In the situation in which the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means-(or step-) plus-function, and the examiner concludes that one skilled in the art would recognize what structure, materials or acts perform the function recited in a means-(or step-) plus-function, the examiner should either: (A) have the applicant clarify the record by amending the written description such that it expressly recites what structure, materials, or acts perform the function recited in the claim element; or (B)

state on the record what structure, materials, or acts perform the function recited in the means- (or step-) plus-function limitation. Even if the disclosure implicitly sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, the USPTO may still require the applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o) to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim element." Since applicant has not pointed to any portion of the specification that shows specifically what structure is used to store the list of raw materials in the computer, exactly what structure is used for populating a plurality of filter lists, exactly what structure is used for displaying a material browser including the filters, exactly what structure is used for selecting one of the filters, or exactly what structure is used for filtering the list of raw materials the objection to the specification set forth by the examiner is considered proper.

Accordingly the petition to have the objections to the specification withdrawn is denied.

With respect to the proposed drawing corrections filed on January 14, 2003, the indication that these corrections were acceptable and overcame the drawing objections was inadvertently omitted from the Office actions.

Accordingly, the petition to have the proposed drawing corrections accepted is granted.

The petition to withdraw the specification objections is denied and applicant must make the necessary amendments to the specification to correct the deficiencies. The petition to accept the drawing corrections is granted and applicant should submit formal copies of the proposed drawing corrections. This application will be forwarded to the examiner for action on the Appeal Brief filed on December 22, 2003.

Summary: *Petition Granted in Part*



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JJL:^{il}rpo: 02/26/04